

## REMARKS

Claims 1-29 and 31 were originally filed in this application. Claims 3, 5 and 26-29 have been withdrawn, and claim 4 has been cancelled. In the Office Action of December 13, 2008, claims 1, 2, 6-25 and 31 have been rejected. Applicants have amended claims 11 and 19, and hereby respond and traverse the rejections as follows.

### Response to Claim Rejections under 35 U.S.C. § 102(b)

Claims 2, 4, 6, 9 and 16 were previously rejected under 35 U.S.C. § 102(b) as being anticipated by McCarty et al. (U.S. 5,946,660) (hereafter “McCarty”). It appears that the Examiner has maintained these rejections. In light of the following remarks, Applicants respectfully traverse these rejections and request reconsideration and withdrawal of the rejections.

#### *Claim 2*

Claim 2 is directed to an automated self-storage management system for enabling a user to conduct self-storage transactions. The system includes an inventory information capture having information pertaining to self-storage units in one or more self-storage facilities, a customer information capture having information pertaining to customers, and a rental transaction feature in communication with the inventory information capture and customer information capture. One or both of the inventory information capture and customer information capture include information for managing the operation of the self-storage facilities, including information on revenue, cash summaries, unit availability, facility utilization, reservations, open contracts, rent rolls and credit card information. The rental transaction feature creates a rental agreement using information from the inventory information capture and the customer information capture. The rental agreement involves a plurality of self-storage units.

In their previous response, Applicants’ noted that the McCarty system is incapable of performing the functions of capturing or tracking information on revenue, cash summaries, unit availability, facility utilization, reservations, open contracts, rent rolls and credit card information, while Applicants’ system can do so. In the present Office Action, the Examiner seems to contend that this is a functional (rather than structural) distinction that it is not entitled

patentable weight. *See* Office Action at 2-3. The Examiner therefore concludes that McCarty discloses all of the structural limitations of claim 2.

Applicants respectfully disagree with Examiner's conclusion for several reasons. First, the subject feature of claim 2 is structural, not functional. Second, even if the recited feature is functional rather than structural, the Examiner's conclusion contradicts applicable law as well as the disclosure of McCarty.

*The subject recitations are structural, not functional.*

Claim 2 recites a system that includes an inventory information capture as well as a customer information capture. Applicants respectfully submit that these are structural limitations. Claim 2 further recites that "one or both of the inventory information capture and customer information capture include information for managing the operation of the self-storage facilities, including information on revenue, cash summaries, unit availability, facility utilization, reservations, open contracts, rent rolls and credit card information." Because this information is included in the information capture structure, it is also a structural limitation. Applicants respectfully submit, therefore, that these recited features should be given patentable weight.

McCarty fails to disclose an inventory information capture or a customer information capture that includes all of the recited information. The Examiner notes that McCarty teaches that his system can be equipped with various management utility programs "for the purpose of adding and/or removing storage facilities to the system" and that may include reporting capabilities "for assessing rental trends, customer tracking, and rental status." Office Action at 2. Applicant respectfully submits, however, that this statement does not disclose an information capture that includes "cash summaries, unit availability, facility utilization, reservations, open contracts, rent rolls and credit card information" as recited in claim 2. Even under the broadest reasonable reading of the cited McCarty language, for example, it does not teach or suggest anything about an information capture that includes cash summaries, reservations or open contracts or rent rolls. Only Applicants' system includes these features.

*Even if the subject recitations are functional, McCarty does not anticipate them.*

The Court of Appeals for the Federal Circuit has acknowledged that the features of an apparatus may be recited either structurally or functionally. *See In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). “[T]here is nothing intrinsically wrong with [defining something by what it does rather than what it is] in drafting patent claims.” 128 F.3d at 1478 (citing *In re Swinehart*, 58 C.C.P.A. 1027, 439 F.2d 210, 212, 169 USPQ 226, 228 (CCPA 1971)). When a claim feature is recited functionally rather than structurally, the prior art can anticipate the claim only if it expressly or inherently includes that feature. *See* 128 F.3d at 1478.

In the present case, even if the subject language of claim 2 is functional, McCarty fails to expressly or inherently teach or disclose the recited functions. As discussed above, McCarty does not expressly disclose the function of capturing information for managing the operation of the self-storage facilities, including capturing information on cash summaries, reservations, open contracts or rent rolls. Moreover, McCarty does not inherently include these functions. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. Rather, in relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. MPEP § 2112. In the present case, the recited features do not necessarily flow from the teachings of McCarty. McCarty’s disclosure that “a management utility program may also include reporting capabilities for assessing rental trends, customer tracking, and unit rental sales” need not necessarily include capturing information on cash summaries, reservations, open contracts or rent rolls. McCarty’s system, therefore, does not expressly or inherently include the functionality to report such information.

For at least these reasons, Applicants respectfully submit that McCarty does not anticipate claim 2.

Claims 6, 9 and 16 depend from claim 2 and include all of the limitations of claim 2. For at least the reasons discussed above with respect to claim 2, Applicants submit that claims 6, 9 and 16 also are patentable over McCarty.

Response to Claim Rejections Under 35 U.S.C. § 103(a)

*Claims 1, 7, 8, 13, 14, 17-22, 24, 25 and 31*

Claims 1, 7, 8, 13, 14, 17-22, 24, 25 and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McCarty in view of Hafen (US2003/0023453). Applicants respectfully traverse and request reconsideration and withdrawal of this rejection.

Claim 1 is directed to an automated self-storage management system for enabling a user to conduct self-storage transactions. The system includes an inventory information capture having information pertaining to self-storage units in one or more self-storage facilities, a customer information capture having information pertaining to customers, and a reporting feature in communication with the inventory information capture and the customer information capture. The reporting feature includes means for generating reports for managing the operation of the self-storage facilities, including reports for revenue, unit availability, reservations, open contracts, rent rolls and credit card information.

In the present Office Action, the Examiner concludes that the functional limitations of claim 1 do not distinguish the claim from the prior art and that “McCarty is capable of performing the limitations of Applicant’s invention without modification.” Office Action at page 3. Applicants respectfully disagree. As discussed above, at the very least, the McCarty system does not expressly or inherently include cash summaries, reservations, open contracts or rent rolls. Moreover, Hafen does not teach or suggest these features. Applicants respectfully submit, therefore, that at least for the reasons discussed above McCarty and Hafen, taken alone or in combination, do not render claim 1 obvious.

Claims 7, 8, 20-22, 24 and 25 depend from claim 2 and include all of the limitations of claim 2. For at least the reasons discussed above with respect to claim 2, Applicants submit that claims 7, 8, 20-22 and 25 also are patentable over McCarty in view of Hafen.

Claims 13, 14 and 17-19 depend from claim 1 and include all of the limitations of claim 1. For at least the reasons discussed above with respect to claim 1, Applicants submit that claims 13, 14 and 17-19 also are patentable over McCarty in view of Hafen.

With respect to claim 13, the Examiner observes that McCarty discloses “reporting capabilities for assessing rental trends, customer tracking, and unit rental status” (*see* col. 11, lines 33-36) and contends that these reporting capabilities are equivalent to Applicants’ recited

“audit report.” Office Action at 4. Applicants respectfully disagree. As the Examiner observes, an “audit” is a review *and verification* of accounts or records. Yet, McCarty’s “assessment of rental trends, customer tracking and unit rental status” does not expressly or inherently include the verification aspect of an audit report. As Applicants describe in their specification, “audit reports are provided to detect or prevent intentional theft and to identify unintentional errors in entering payments, fee waivers, and write-offs.” Specification at [005]. Applicants respectfully submit that nothing in McCarty teaches or suggests such reports.

With respect to claim 14, the Examiner further contends that neither McCarty nor Hafen specifically discloses “a cash intake report” as recited in Applicants’ claim. The Examiner notes that Hafen discloses a report projecting future rents and concludes that because all forms of rent payment “are at some point in time exchanged for usable cash by the company,” the Hafen rent projection report is a “cash intake report.” Applicants respectfully disagree. Even if non-cash payments, such as credit card payments, may be exchanged in the future for cash, they are still non-cash receipts. Moreover, although McCarty discloses that a customer can make a cash payment at a kiosk, nothing in McCarty discloses a reporting feature that includes means for generating a cash intake report for the facility.

With respect to claim 19, the Examiner asserts that McCarty discloses “a facility utilization report” as recited in Applicants’ claim. The Examiner contends that McCarty’s disclosure of a capability to report “unit rental status” is equivalent to Applicants’ recited facility utilization report. As Applicants previously observed, their facility utilization report provides much more comprehensive utilization information than rental status. This information includes facility revenue and occupancy information for evaluating the effect of a new rate on revenue. *See* Applicants’ specification at paragraph [0095]. Applicants have amended claim 19 to emphasize this point.

Claim 31 is directed to an automated self-storage management system enabling a user to conduct self-storage transactions. The system includes an inventory information capture having information pertaining to self-storage units, a customer information capture having information pertaining to customers, a rental transaction feature configured to create a rental agreement using information from the inventory information capture and the customer information capture, and a

reporting feature in communication with the inventory information capture and the customer information capture. The rental agreement involves a plurality of self-storage units. The reporting feature includes means for generating reports for managing the operation of the storage facility, including reports for revenue, cash summaries, unit availability, facility utilization, reservations, open contracts, rent rolls and credit card information.

For the reasons discussed above with respect to claim 2, the Examiner contends that McCarty discloses “means for generating reports for managing the operation of the self-storage facilities, including reports for revenue, cash summaries, unit availability, facility utilization, reservations, open contracts, rent rolls and credit card information” as recited in claim 31. Applicants respectfully submit, as discussed above, that McCarty fails to disclose an information capture that includes cash summaries, reservations, open contracts or rent rolls. Applicants submit, therefore, that claim 31 is patentable over McCarty in view of Hafen.

*Claim 10*

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over McCarty. Applicants traverse and request reconsideration and withdrawal of this rejection.

Claim 10 depends from and includes all of the limitations of claim 2. For the reasons discussed above with respect to claim 2, Applicants submit that claim 10 also is patentable over McCarty.

*Claims 11 and 23*

Claims 11 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McCarty in view of Hafen (as applied to claims 2 and 22) and further in view of the Examiner’s Official Notice. Applicants respectfully traverse and request reconsideration and withdrawal of this rejection.

Claims 11 and 23 depend from and include all of the limitations of claim 2. For at least the reasons discussed above with respect to claim 2, Applicants submit that claims 11 and 23 also are patentable over McCarty in view of Hafen and further in view of the Examiner’s Official Notice.

The Examiner previously took Official Notice that it is well known to move a customer, such as a hotel customer, from an occupied room to a vacant room. In the present Office Action,

as support for the Official Notice, the Examiner cites a San Jose Mercury News article by Daniel Vasquez and Rodney Foo, dated July 22, 2000 and entitled “Housing Crunch Adds to Fire Victims’ Woes S.J. Residents Face Dilemma: Pay Higher Rents or Leave Area”. This article describes how residents of two apartment complexes that burned had difficulty finding new rental housing to which to move.

Applicants respectfully question whether the cited article supports the Examiner’s official notice. In any event, Applicants submit that the knowledge that apartment residents move from a burned apartment to a different apartment does not render Applicants’ claim 11 obvious. Such moves do not relate to the self-storage rental business. Yet, Claim 11 is directed to an automated self-storage management system that includes a transfer feature that transfers a customer between rental self-storage units. Applicant has amended claim 11 to emphasize this point.

*Claim 12*

Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over McCarty in view of Hafen (as applied to claim 11) and further in view of Official Notice and Inomata (U.S. 6,999,825). Applicants traverse and request reconsideration and withdrawal of this rejection.

Claim 12 depends from claim 11 and includes all of the limitations of claim 11. For at least the reasons discussed above with respect to claim 11, Applicants submit that claim 12 also is patentable over McCarty in view of Hafen and further in view of the Examiner’s Official Notice and Inomata.

*Claim 15*

Claim 15 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over McCarty in view of Hafen (as applied to claim 1) and further in view of Gross (U.S. 6,721,716). Applicants traverse and request reconsideration and withdrawal of this rejection.

Claim 15 depends from claim 1 and includes all of the limitations of claim 1. For at least the reasons discussed above with respect to claim 1, Applicants submit that claim 15 also is patentable over McCarty in view of Hafen and further in view of Gross.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

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Respectfully submitted,

/Richard E. Oney/  
Richard E. Oney  
Registration No. 36,884  
Tiffany & Bosco, P.A.  
2525 E. Camelback Road, Third Floor  
Phoenix, Arizona 85016  
Tel: (602) 255-6094